

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

Applicant(s): SZU et al.

Group Art Unit: TBA

Serial No.: 09/744,289

Examiner: TBA

Filed: January 22, 2001

For: VACCINES AGAINST ESCHERICHIA COLI O157 INFECTION

EXPRESS MAIL CERTIFICATE

RECEIVED

Express Mail Label No.: EL853248581US

01 FEB 2002

Date of Deposit: January 30, 2002

Legal Staff

International Division

I hereby certify that the following attached paper(s) and/or fee

1. Transmittal Letter (2 copies)
2. Response to Decision on Papers under 37 CFR 1.42, including copy of Notification
3. Executed Combined Declaration and Power of Attorney form for Shousun Chen Szu and John B. Robbins
4. Executed Combined Declaration and Power of Attorney form for Yvonne Agyeman Konadu
5. Copy of the Statutory Declaration of Mrs. Yvonne Agyeman Konadu dated October 22, 1998
6. Return Receipt Postcard

is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. §1.10 on the date indicated above and is addressed to the Commissioner for Patents, BOX PCT, Washington, D.C. 20231, Attention: Office of PCT Legal Administration.

Jesus R. Remedios

(Typed or printed name of person mailing paper(s) and/or fee)

(Signature of person mailing paper(s) and/or fee)

Correspondence Address:

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Rec'd PCT/PTO 01 FEB 2002

Docket No. 2026-4282

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s): SZU et al.

Group Art Unit: TBA

Serial No.: 09/744,289

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Filed: January 22, 2001

For: VACCINES AGAINST ESCHERICHIA COLI O157 INFECTION

TRANSMITTAL LETTER

COMMISSIONER FOR PATENTS  
BOX PCT  
WASHINGTON, D.C. 20231

ATTENTION: OFFICE OF PCT LEGAL ADMINISTRATION

Sir:

Transmitted herewith are:

1. Express Mail Certificate, including Express Mail Label No. EL853248581US
2. Response to Decision on Papers under 37 CFR 1.42, including copy of Notification
3. Executed Combined Declaration and Power of Attorney form for Shousun Chen Szu and John B. Robbins
4. Executed Combined Declaration and Power of Attorney form for Yvonne Agyeman Konadu
5. Copy of the Statutory Declaration of Mrs. Yvonne Agyeman Konadu dated October 22, 1998
6. Return receipt postcard

The Commissioner is hereby authorized to charge any additional fees which may be required by any of these papers, or credit any overpayment to Deposit Account No. 13-4500, Order No. 2026-4282. A DUPLICATE COPY OF THIS SHEET IS ATTACHED.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: January 30, 2002

Mailing Address:

MORGAN & FINNEGAN, L.L.P.

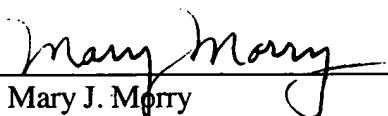
345 Park Avenue

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678727 v1

By:

  
Mary J. Morry  
Registration No. 34,398

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : SZU et al.  
Serial No. : 09/744,289 Group Art Unit: TBA  
Filed : January 22, 2001 Examiner: TBA  
For : **VACCINES AGAINST ESCHERICHIA COLI O157  
INFECTION**

RESPONSE TO DECISION ON PAPERS UNDER 37 CFR 1.42

COMMISSIONER FOR PATENTS  
BOX PCT  
WASHINGTON, D.C. 20231

ATTENTION: OFFICE OF PCT LEGAL ADMINISTRATION

Sir:

In response to the DECISION ON PAPERS UNDER 37 CFR 1.42 mailed December 5, 2001, submitted herewith are new executed Combined Declaration and Power of Attorney forms, signed by the named inventors, Dr. Shousun Szu and Dr. John Robbins, on their own behalf and signed by Yvonne Ageyman Konadu as legal representative and sole heir to the estate of the deceased inventor, Dr. Edward Konadu, together with a copy of the Notification itself. The new declaration forms have proper page numbering and indicate the last known address of the deceased inventor and the current address of Mrs. Yvonne Ageyman Konadu, his legal representative and sole heir. In support of Mrs. Konadu's position, submitted herewith is a copy of the Statutory

PATENT

Docket No. 2026-4282

Declaration of Mrs. Yvonne Agyeman Konadu dated October 22, 1998, which was notarized by a Notary Public of Ghana, certified by the Consul of the United States of America on October 28, 1998, and filed in the international phase of the above captioned application (i.e., PCT/US98/14976), on November 6, 1988. Please note that the last known residence address of Dr. Edward Konadu is House No. Plot 3, 2nd Street, Asokore Mampong, Ashanti Region, Ghana; and the last known mailing address is P.O. Box 1796, Kumasi-Adum, Ghana. Mrs. Konadu had the same addresses until recently. Her new address, which is 1283 East 224 Street, Bronx, New York 10466, USA, is set forth on the new declaration form.

Applicants believe that no fees are due. However, if that is not the case, the Examiner is authorized to charge deposit account 13-4500, order no. 2026-4282, for any fee that may be due.

Respectfully submitted,  
MORGAN & FINNEGAN, L.L.P.

Dated: January 30, 2002

By: Mary J. Morry  
Mary J. Morry  
Registration No. 34,398

Mailing Address:  
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DEC 05 2001

02026-4282

MJM

UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS  
UNITED STATES PATENT AND TRADEMARK OFFICE  
WASHINGTON, D.C. 20231  
www.uspto.gov

William S. Feiler, Esq.  
Morgan & Finnegan  
345 Park Avenue  
New York, NY 10154-0053

In re Application of  
SZU, et al.  
Application No. 09/744,289  
PCT No. PCT/US98/14976  
Init. Filing Date: 20 July 1998  
Priority Date: N/A  
Attorney's Docket No. 2026-4282US  
For: VACCINES AGAINST ESCHERICHIA  
COLI 0157 INFECTION

DECISION ON

PAPERS

UNDER 37 C.F.R. 1.42

This is a decision on applicants' "RESPONSE TO NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371" filed 1 August 2001, which has been treated as a request for acceptance of the application filed on behalf of a deceased inventor under 37 C.F.R. 1.42.

BACKGROUND

On 20 July 1998, applicants filed international application PCT/US98/14976. A Demand electing the United States was filed with the International Preliminary Examining Authority within nineteen months of the priority date. Accordingly, the deadline for submitting the basic national fee to prevent abandonment of the international application as to the United States expired at midnight of 22 January 2001 (20 January 2001 was a Saturday).

On 22 January 2001, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 6 February 2001, the USPTO mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors was required. This Notification set a one month extendable period for reply.

On 1 August 2001, applicants filed the instant "Response to Notification of Missing Requirements Under 35 U.S.C. 371 in the United States Designated/Elected Office (DO/EO/US)," including, *inter alia*, two combined declarations and powers of attorney, a copy of the notification and a check in the amount of \$1890.00 for a five month extension. One declaration is numbered 1/3, 2/3, 3/3, 4/3 with signatures from the two joint inventors and identifies Yvonne Ageyman Konadu as the "third joint inventor" and "as heir to the estate of

deceased inventor and applicant Edward Konadu." The second declaration is numbered 1/4, 2/4, 3/4, 4/4 and identifies the third joint inventor as Edward Konadu and Yvonne Agyeman Konadu as "representative and heir to the estate of deceased inventor Edward Konadu."

### DISCUSSION

It is first noted that the application file contains an uncashed check in the amount of \$2252.00, which amount corresponds to the amount indicated in the transmittal letter that was submitted with the national stage papers on 22 January 2001. It is unclear why the check was not processed, though it is noted that the left side of the check was truncated. In any event, all required fees have been timely paid and accordingly, the check is being returned herewith.

Under 37 C.F.R. 1.497(a)(3), a declaration must identify, *inter alia*, each inventor. The declaration signed by the inventors Szu and Robbins is numbered 1/3, 2/3, 3/3, and 4/3. It is presumed, notwithstanding the incorrect page numbering, that page 4/3 was attached to the declaration at the time of execution by inventors Szu and Robbins. If this is incorrect, a new oath or declaration by Szu and Robbins is required in response to this decision.

Under 35 U.S.C. §117, legal representatives of deceased inventors may make application for patent upon compliance with the requirements and on the same terms and conditions applicable to the inventor. The "legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent." 37 C.F.R. 1.42.

In the declaration signed by Yvonne Agyeman Konadu as "representative and heir" of Edward Konadu, a residence, citizenship and post office address are given, but it is not clear to whom they belong, that is to either Edward Konadu or Yvonne Konadu. Under 37 C.F.R. 1.497 and 37 C.F.R. 1.63, the declaration must include the residence, mailing address and citizenship of both the legal representative and the deceased inventor. Moreover, the declaration does not indicate that Ms. Konadu is the "legal representative" or "sole heir" of the deceased inventor. If a legal representative has been or is required to be appointed under applicable law, such person must sign the declaration and indicate the relationship, e.g., "legal representative of inventor Edward Konadu." Otherwise, all heirs of Edward Konadu must sign the declaration and indicate the relationship, e.g., "sole heirs of Edward Konadu," or "legal representative of Edward Konadu."

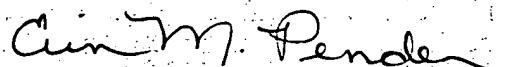
### CONCLUSION

For the above reasons, the request for status under 37 C.F.R. 1.42 is **REFUSED**.

Applicant is required to submit an oath or declaration in compliance with 37 C.F.R. 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 C.F.R. 1.136(a). FAILURE TO

PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 C.F.R. 1.42."

Please direct any further correspondence with respect to this matter to the Commissioner of Patents and Trademarks, Box PCT, Washington, D.C. 20231, and address the contents of the letter to the attention of the Office of PCT Legal Administration.



Erin M. Pender  
Attorney Advisor  
PCT Legal Affairs

Telephone: (703) 305-0455  
Facsimile: (703) 308-6459

Attachment: Check #21641 in the amount of \$2,252.00



Boris Milef  
PCT Legal Examiner  
PCT Legal Affairs

CASE 2026-4282 ATTY MM  
DUE DATE February 5, 2002  
STATUTORY DATE July 5, 2002  
BY gr